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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL R. SCHLINZ and ROBERT E. VOGT

Appeal 2009-012301
Application 10/750,188
Technology Center 3700

Before MICHAEL W. O'NEILL, STEFAN STAICOVICI, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Daniel R. Schlinz and Robert E. Vogt (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1, 2, and 7-16. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The Invention

The claimed invention is to a disposable absorbent garment.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A disposable absorbent garment having a longitudinal direction and a lateral direction; a front waist region, a back waist region and a crotch region that connects the front waist region and the back waist region; a waist region width in the lateral direction and a crotch region width in the lateral direction that is less than the waist region width, and two longitudinal side edges, the disposable absorbent garment comprising:

a liquid barrier layer defining an inner surface, an outer surface, opposite longitudinal side edges and a liquid barrier layer width between the opposite longitudinal side edges of about the crotch region width;

a stretchable carrier layer extending from the front waist region to the back waist region and placed in facing relationship with the liquid barrier layer, the stretchable carrier layer having a width in the waist regions of about the waist region width and a width in the crotch region of about the crotch region width;

an elastic layer attached to the stretchable carrier layer, the elastic layer having an elastic layer width extending away from a lateral centerline of the disposable absorbent garment in the lateral direction from a liquid barrier layer longitudinal side edge to a disposable absorbent garment longitudinal side edge; and

an absorbent section disposed on the inner surface of the liquid barrier layer.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Van Gompel	US 4,938,753	Jul. 3, 1990
Kuen	US 5,931,825	Aug. 3, 1999
Krzysik	US 6,515,029 B1	Feb. 4, 2003

The Rejections

The following Examiner's rejections are before us for review:

Claims 1, 2, and 7-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuen and Krzysik.

Claims 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuen, Krzysik, and Van Gompel.

OPINION

Issue

Whether the Examiner presents sufficient evidence and technical reasoning to establish the reasonable belief that Kuen's outer cover is stretchable as the term "stretchable" is lexicographically defined within the Specification such that the limitation of the carrier layer having a stretchable characteristic is met by Kuen in order to shift the burden to Appellants to prove that the outer layer disclosed in Kuen does not possess the characteristic relied on to establish patentability over Kuen.

Pertinent Facts

1. Appellants' Specification discloses "stretchable carrier layer 80 may be formed of a stretchable material, such as an extensible material." Spec. 10:8-9.

2. Appellants' Specification explains that "[s]retchable materials are generally understood to be materials that are capable of extending from their original length when a pulling force is applied." *Id.* at 9-11.
3. Appellants' Specification explains that "[e]xtensible materials generally include materials that are capable of elongating but that do not completely retract to their original length when the pulling force is removed." *Id.* at 11-13. That is, "[e]xtensible materials generally experience a degree of permanent deformation after elongation." *Id.* at 13-14.
4. Appellants' Specification discloses that "stretchable carrier layer 80 may be formed from one or more materials including nonwoven materials, film materials and elastomers." *Id.* at 18-19.
5. The Examiner finds that Kuen discloses "a stretchable carrier layer 46 placed in a facing relationship with the barrier layer 48, as shown in figure 3." Ans. 3.
6. The Examiner finds that "[t]he stretchable carrier layer 46 comprises a nonwoven material, as disclosed in column 4, lines 28-29 [of Kuen], which is fully capable of being stretched." *Id.*
7. Kuen discloses layer 46 can comprise a spunbond polypropylene nonwoven web. Col. 4, ll. 30-31.
8. The Examiner finds that "[a] nonwoven web, while not inherently elastically stretchable, is fully capable of being stretched when subjected to pulling forces." Ans. 5.
9. The Examiner finds that the present claims are not limited to require elasticity. *Id.*

10. The Examiner finds that the present claims are just limited to a carrier layer “that is able to be stretched.” *Id.*
11. The Examiner finds that the broadest reasonable interpretation of the claim term “stretchable” is found within Appellants’ Specification (*Id.*), *see* Facts 1-3, *viz.*, a material that is able to elongate under pulling forces, irrespective of returning to its original shape.
12. The Examiner finds that Appellants’ Specification discloses that suitable materials for the claimed stretchable outer cover include nonwoven materials. Ans. 6. *See also* Fact 4.
13. The Examiner finds that since both Appellants’ Specification and Kuen disclose nonwoven materials are suitable for outer covering layers, Kuen’s layer 46 is fully capable of exhibiting the same properties as the claimed carrier layer, i.e., capable of being stretched. Ans. 6.

Principles of Law

Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not”); *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986); *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or

substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”) Nevertheless, before an applicant can be put to this burdensome task, the examiner must provide sufficient evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

Analysis

Appellants’ Specification discloses an embodiment of the claimed carrier layer as being formed from a stretchable material that is capable of extending from its original length when a pulling force is applied, and an example of such a material is an extensible material. Facts 1 and 2. Appellants define extensible materials as materials that are capable of elongating upon application of a pulling force, but do not completely retract to the original length when the pulling force is removed. Fact 3. In other words, extensible materials experience a degree of permanent deformation after elongation. *Id.* Appellants’ Specification discloses that at least nonwoven materials may form the claimed carrier layer. Fact 4.

The characteristic alleged to be inherent in the prior art must be necessarily present. However, as noted above, where the alleged inherent characteristic is a function or intended use of the device, Appellants, and not the Patent Office, are in the best position to establish the existence or non-existence of this characteristic. Thus, as was done by the Examiner (Ans. 5-

6), the Patent Office may shift the burden to Appellants to prove that the prior art does not possess the characteristic alleged by the Examiner to be inherent. Nevertheless, we recognize that before the Appellant can be put to this burdensome task, the Examiner must provide sufficient evidence or reasoning to establish the reasonableness of the Examiner's belief that the functional limitation is an inherent characteristic of the prior art.

The Examiner found Kuen discloses a carrier layer in the claimed orientation with the barrier layer, and the carrier layer comprises a nonwoven material, e.g., spunbond polypropylene nonwoven web. Facts 5-7. Given these findings and Appellants disclosure of what constitutes a carrier layer (Facts 1-4), the Examiner reasonably found that the structural similarities of Kuen and the claimed invention, read in light of the Specification, provided a sufficient basis to conclude that Kuen's layer could perform all the recited functions and uses, i.e., capable of being extensibly stretched when pulling forces are applied. Facts 8-10. Accordingly, in our view, the Examiner has presented a sound basis for reaching the conclusion that the Kuen layer is fully capable of performing or exhibiting the same properties as the claimed carrier layer since both layers are formed by at least a nonwoven web material. Therefore, the burden shifted to the Appellants to show that Kuen's carrier layer is not the same as the claimed carrier layer. This the Appellants have not done.

Instead, Appellants have merely recited what is expressly disclosed within a particular passage of Kuen that deals with the texture of Kuen's layer. App. Br. 4. Further, Appellants contend the Examiner's statements are conjecture. App. Br. 5. However, as we have shown above the Examiner's statements are not conjecture, but have a sound basis in the

evidence of record and technical reasoning. As such, the burden shifted to the Appellants to show that the claimed carrier layer is not the same Kuen's carrier layer.

We have considered Appellants' other arguments; however, we do not find any of them persuasive to demonstrate that the claimed invention would not have been obvious to a person of ordinary skill in the art at the time of the invention given the evidence and analysis set forth by the Examiner.

CONCLUSION

The Examiner presented sufficient evidence and technical reasoning to establish the reasonable belief that Kuen's outer cover is stretchable as the term "stretchable" is lexicographically defined within the Specification such that the limitation of the carrier layer having a stretchable characteristic is met by Kuen in order to shift the burden to Appellants to prove that the outer layer disclosed in Kuen does not possess the characteristic relied on to establish patentability over Kuen.

Accordingly, we sustain the Examiner's rejections of claims 1, 2, and 7-16 under 35 U.S.C. § 103(a) as being unpatentable over Kuen and Krzysik and Claims 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Kuen, Krzysik, and Van Gompel.

DECISION

The Examiner's decision to reject claims 1, 2, and 7-16 as unpatentable is affirmed.

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Application 10/750,188

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

Klh